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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/248,077	02/10/1999	DAVID J. LADD	1298/0E486	8370

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EXAMINER

SALAD, ABDULLAHI ELMI

ART UNIT	PAPER NUMBER
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2157

19

DATE MAILED: 01/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/248,077

Applicant(s)

LADD, DAVID J.

Examiner

Salad E Abdullahi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 10 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-16, 27-30 and 33-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-16, 27-30 and 33-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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Response to Amendment

1. Applicant's arguments with regard to claims 12-16, 27-30 and 35-59 have been fully considered but are not persuasive for the following reasons.

(a) with regard to claims 12 and 27, applicant alleges " the claims require that audio representation is to a voice mailbox remote from the wireless portable device" further alleging " there is no teaching or suggestion in the prior art of record to send travel the directions in text format to the mailbox remote from the wireless unit, in the first place, so that funk's system can translate the text message into a voice mail" (see page 12, lines 3-11).

In response to applicant's argument with respect to (a). Examiner respectfully disagrees: First, Behr's system discloses for receiving an information request (travel direction) from wireless portable device (variety of mobile units 20, 18), accessing an informational database (map database 72) and retrieving a text information in response to the request. Behr is silent regarding processing the text information into text-to-voice to generate an audio representation and transmitting the audio to voice mail box remote from the wireless portable device. Funk fills this gap by disclosing a system which provides personalized service to respective users including the step of receiving an information from a source 100 (database), translating the information with text-voice-processor and delivers generated voice to user's voice mail box as requested by the user (col. 3, lines 43 to col. 4, line 24). Furthermore, Funk's system (see fig. 1) shows the voice mail service 110 is remote from the end-user system 114. Hence, one having ordinary skill in the art at the time of the invention would have readily recognized the advantage of Funk's

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teaching to the Behr's system as it provides a translation service as well as customized or personalized information via email or fax or voice mail based on the user's choice (see col. 1, lines 58-61).

(b) with regard to claims 36 and 44, applicant alleges the prior art of record does not teach or suggest fail to make any mention of a call taker who manually enters data (see page 13, lines 3-8). Examiner respectfully disagrees, because Behr teaches the base unit 12 includes means of receiving cellular telephone call and a operator unit which inputs data into the system (see col. 1, lines 38-42 and col. 6, lines 55-60).

(c) with regard to claims 49 and 55, applicant alleges office action fails to address the travel direction (information request) is received as a voice form. Examiner disagrees, because the base of unit of Behr includes an I/O interface for coupling the base unit with plurality of communication medium including wireless, wire line, cellular telephone system with plurality of mobile units (see col. 6, lines 55-60 and col. 7, lines 55 to col. 8, line 36).

Funk also teaches receiving a message in variety of forms including a voice form (see col. 6, lines 30-37).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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3. Claims 12-16, 27-30 and 35-58, are rejected under 35 U.S.C. 103(a) as being unpatentable over Behr et al U.S. Patent No. 5,543,789, in view of Funk U.S. Patent No. 5,793,497.

As per claims 12 and 27, Behr et al discloses a system for communicating with a wireless information device comprising the steps:

- receiving an information request (route guidance or route direction), (see fig. 1, the abstract and col. 5, line 66 to col. 6, line 13);
receiving a device identification from a wireless device (to receive a response to the information request a device identification would have been obviously included with the information request). For example it would have been obvious the remote unit (pager 20) to provide the base unit a device identification which should receive response to the information request (see also col. 12, lines 24-37).
- accessing an informational database with the information request (see fig. 1, element 72);
- receiving from the informational database text format information in response to the request (see abstract);

Behr et al does not explicitly disclose:

processing the text format with text-to-voice processor to generate an audio representation to the responsive information and sending the audio representation in mailbox remote from the wireless portable device.

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Funk, discloses a messaging system, for providing a personalized or customized information delivery system via (email or voice mail or fax) including a translation facility (220) that provides subscriber services such as text-to-voice translation. The audio representation generated by the translation facility is further transmitted or stored in a subscriber voice mailbox (see figs. 1 and 2, elements 110, 220 and col. 3, line 36 to col. 4, line 56). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention presented with teaching of Funk to modify Behr et al to include the translation services as discloses by Funk, in order to provide customized or personalized information delivery via email or fax or voice mail based on the user's preferences (see col. 1, lines 58-61).

- In considering 13-14, Behr et al discloses a system, wherein the information request contains plurality of geographic locations and the responsive information comprises driving direction between locations (see col. 3, line 51-67).
- In considering claims 15 and 40-41, Behr et al discloses a system, wherein the driving directions are provided in text or graphic format (see col. 3, line 51-67).
- in considering claims 28 and 29, Behr et al discloses a system, wherein the receiver comprises a computer server (see col. 3, line 46 and col. 4, lines 6-20).
- In considering claim 35, Funk, discloses recording the audio message in the mailbox for later retrieval (see element 110, the voice mail service which obviously stores voices messages for later retrieval)

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- As per claims 36, and 44, The claims recite limitations analogous to those limitation recited in claims 12 and 27, further reciting: having a call taker manually enter information (see Behr col. 1, lines 38-42 and col. 6, lines 55-60, where an operator inputs data into the system receiving and where the base station is capable of receiving cellular telephone calls send by the mobile stations)
- In considering claims 37, 45, 50-51 and 56, Behr et al discloses the first information or the query includes an identifier which uniquely identifies the portable device (see col. 12, lines 24-36).
- In considering claims 38-39 and 46-47, 52-53 and 57, Behr et al further discloses the query or the first information includes routing information (see col. 11, lines 5-12).
- in considering claim 43, Behr et al., further discloses the step of accessing the informational database occurs over a dedicated line(see fig.1).

In considering claims 16, 30, 42, 48, 54 and 58, Funk discloses a system for accessing an informational database over a network, in particular the Internet obviously HTTP emulation the communications network through which the informational database is accessed includes Internet (see figs. 1 and 2, elements 110, 220 and col. 3, line 36 to col. 4, line 56).

As per claims 49 and 55. The claims recite limitations analogous to those limitation recited in claims 12 and 27, further reciting: receiving a voice call from a person desiring information

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(See Behr, see col. 6, lines 55-60 and col. 7, lines 55 to col. 8, line 36, where the base of unit of includes an I/O interface for coupling the base unit with plurality of communication medium including wireless, wire line, cellular telephone system with plurality of mobile units).

4. Claim 59 is rejected under 35 U.S.C. 103(a) as being unpatentable over Behr et al., and Funk.

As per claim 59, Although, Behr and Funk disclose substantial features of the claimed invention, they are silent regarding: the wireless portable units (mobile units) include a cellular telephone.

However, utilizing cellular telephone would have been an obvious modification with the system of Behr and Funk. Furthermore, Behr's base unit includes an interface with cellular telephone system which may interact with cellular telephone units. Additionally, Behr teaches mobile units may include other types mobile units(see col. 7, lines 36-54). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention provided the system of Behr and Funk to utilize cellular telephone set because a major advantage of cellular telephone is mobility it provides to the user when traveling.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

CONCLUSION

6. The prior art made of record and not relied upon is considered pertinent to the applicants disclosure.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Abdullahi E. Salad** whose telephone number is **(703) 308-8441**. The examiner can normally be reached on Monday to Friday from **8:30 AM to 5:00 PM**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Etienne, Ario** can be reached at **(703)308-7562**. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is **(703)305-3900**.

Any response to this action should mailed to:

Box AF


Commissioner of Patents and Trademarks
Washington, DC 20231

or faxed to:

(703) (872-9306).

As

1/24/2004


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